

Remarks:

The applicants note with appreciation the Examiner's indication that the subject matter of claims 10-13 and 20 would be allowable if rewritten in independent form.

Status of Claims

Claims 1-39 are pending in this application. Claims 30-39 were withdrawn from prosecution pursuant to applicants' election of claims 1-29, without traverse, in response to a restriction requirement.

Claims 1-9, 14-19, and 21-29 were rejected by the Office Action of November 2, 2004 (the Office Action). Claims 1, 5, 13, 19, 21, and 22 were rejected under 35 U.S.C. §102 as anticipated by United States Patent No. 6,648,913 to Yee et al. (Yee). Claims 2-4, 6-9, 14-18, and 23-29 were also rejected under 35 U.S.C. § 103 as unpatentable over Yee. Finally, claims 10-13 and 20 were objected to for depending from a rejected base claim.

Preliminary Remarks: Exclusion of Yee as a § 103(a) Reference

As is evident on the face of the issued patent, Yee is assigned to Scimed Life Systems, Inc. The assignee of this application is Boston Scientific Corporation (now Boston Scientific Scimed, Inc). Boston Scientific Corporation and Scimed Life Systems, Inc. were commonly owned at the time of the invention of the claimed subject matter of this application and have since merged into Boston Scientific Scimed, Inc.

The inventors of this application were under a common duty to assign the subject matter of this application to (then) Boston Scientific Corporation at the time of their invention. Thus, by operation of 35 U.S.C. §103(c), the subject matter of Yee is excluded for the purposes of an obviousness determination under 35 U.S.C. § 103(a). Therefore the applicants respectfully submit that the rejection of claims 2-4, 6-9, 14-18, and 23-29 should be withdrawn. The applicants further request that the objection to claims 10-12 also should be withdrawn because they depend directly, or indirectly, from claim 9.

35 U.S.C. § 102:

Applicants respectfully traverse this rejection as an improper rejection under § 102. As background, claim 1 recites:

1. A braided modular stent comprising a first component and a second component, each component comprising an hourglass-shaped interface, each hourglass shaped interface comprising a reduced diameter section positioned between two sloped sections, each sloped section extending between the reduced diameter section and one of a plurality of nominal diameter sections, *the reduced diameter section having a greater radial strength than the nominal diameter sections.* (emphasis added).

In the course of the § 102(e) rejection, the Office Action appears to address the emphasized limitations that recite increased radial strength only where it states:

Alternatively, one can provide a reduced diameter section/interface area/conical seal region having a greater radial strength than that of a nominal section in a Yee-'931 stent so as the reduced diameter section/interface area/conical seal region can sustain more pressure existed in this region when two components are deployed in a branch blood vessel. (Office Action, page 3).

The Office Action does not point to a teaching or suggestion in the disclosure of Yee that supports such a rejection. Absent some teaching or suggestion in Yee of an increased radial strength at its reduced diameter portions, Yee cannot anticipate applicants' invention because it fails to recite each and every limitation.

Instead, the Office Action appears to suggest by the above statement that it would have been obvious to modify the device disclosed by Yee to include a greater radial strength at the reduced diameter section. If this is a correct interpretation of the intent of the rejection, then the applicants respectfully submit that this rejection would be properly characterized as an obviousness rejection under § 103(a) and not as a § 102 rejection. As noted above, this reference is unavailable for the purposes of § 103(a) rejection, and therefore this rejection (properly reframed as a § 103(a) rejection) must be withdrawn. The rejection of independent claims 1 and 26 should therefore be withdrawn. Furthermore, the rejection of claims 2-9, 14-19, 21-25, and 27-29 should be withdrawn because the claims depend, directly or indirectly, from allowable independent claims 1 and 26.

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Conclusion

For the foregoing reasons, the rejection and objection of the pending claims should be withdrawn. A notice to this effect is earnestly requested.

Respectfully submitted,



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January 26, 2005



Ruth Curran